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EXAMINER

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Please find below and/or attached an Office communication concerning this application or proceeding.

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/694,402
Filing Date: October 22, 2000
Appellant(s): PIENKOS, JOHN THADDEUS

John T. Pienkos
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 5/26/09 appealing from the Office action mailed 7/24/08.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

4,831,526	LUCHS et al.	5-1989
6,272,528	CULLEN et al.	6-2001
5,873,066	UNDERWOOD et al.	2-1999

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5,845,256

PESCITELLI et al.

12-1996

Felton, Bruce, "Rental Car Insurance: Staying out of financial potholes", The New York Times, March 23, 1997, pg. 3, 11.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Luchs et al. (4,831,526), Felton (Felton, Bruce, "Rental Car Insurance: Staying out of financial potholes," The New York Times, March 23, 1997, pg. 3, 11), Cullen et al. (6,272,528), Underwood et al. 5,873,066 and in view of Pescitelli et al. (5,845,256).

As per claim 26, Luchs teaches a method of providing insurance coverage to a customer, the method comprising:

(a) during a preliminary period of time:

- (1) receiving an initial inquiry from the customer (col. 3 lines 16-38);
- (2) providing an input form including at least one field for an entry of a piece of information concerning at least one of a characteristic of the customer and a characteristic of an item to be insured (Fig. 10A-B, col. 3 lines 17-38, col. 22 line 5 to col. 23 line 28);

(3) receiving the piece of information following its entry into the input form and submission (col. 2 line 55 to col. 3 line 5, col. 22 lines 5-35, col. 28 lines 20-52);

(4) performing processing in relation to the piece of information (col. 4 lines 26-47, col. 7 line 28 to col. 11 line 2, col. 16 line 30 to col. 17 line 5);

(5) providing a preliminary indication to the customer that the customer will have an ability to order at least one of temporally-limited amounts of insurance and geographically-limited amounts of insurance (Fig. 10A-B, col. 22 line 5 to col. 23 line 28); and

(6) providing an identifier to the customer (Fig. 1, 10A-B, col. 2 line 55 to col. 3 line 5, col. 3 lines 16-39, col. 5 line 61 to col. 6 line 12, col. 7 line 28 to col. 20 line 50, col. 22 lines 5-35, col. 28 lines 20-52); and

(b) at a subsequent period of time:

(1) providing a field for an input of a limitation relating to a desired insurance coverage regarding a customer-owned item, (Fig. 10A-B, col. 22 line 5 to col. 23 line 28);

(2) receiving the limitation at a central processor as provided by way of a customer-operated terminal (col. 2 line 55 to col. 3 line 5, col. 22 lines 5-35, col. 28 lines 20-52);

(3) performing processing in relation to the limitation to determine whether the desired insurance coverage as restricted by the limitation can be provided (col. 4 lines 26-47, col. 7 line 28 to col. 11 line 2, col. 16 line 30 to col. 17 line 5);

(4) sending a confirmation to the customer-operated terminal concerning whether the desired insurance coverage corresponding to the limitation can be provided (col. 16 lines 30-52);

(8) recording information regarding the desired insurance coverage as restricted by the limitation in an insurance company database.

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Luchs includes the feature of receiving a customer specification setting time limits regarding a desired amount of insurance coverage (i.e., the effective date and the expiration date). However, Luchs does not include the feature of the time limit specifying a time period of less than a month as well as at least one of temporally-limited amounts of insurance and geographically-limited amounts of insurance.

Felton discloses in his article that it is well known in the insurance arts to provide insurance to customers, wherein the insurance is limited to periods of time of 15 days or 30 days (pg. 2, par. 7).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the features of Felton within the method of Luchs with the motivation of allowing a customer to reduce the high cost of insurance (Felton; page 1).

Luchs and Felton do not expressly disclose the terminal being customer operated. However, Luchs clearly discloses a terminal. See Figure 1 and col. 3 lines 5-15.

Cullen discloses obtaining details of a user's requirements for an insurance quotation via a user's computer, receiving by way of a mobile agent, the user's requirements for an insurance quotation at a server, and delivering the insurance quotation information, such as the types of insurance available and the price of the insurance based on insurer-specific underwriting rules (reads on "confirmation"), to the user at the user's computer, wherein the user's computer is operated by a customer wishing to purchase vehicle insurance (col. 1 lines 10-18, col. 2 lines 1-11, col. 3 lines 1-21, col. 6 line 60 to col. 7 line 15, col. 7 line 15 to col. 8 line 32).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the features of Cullen within the method taught collectively by Luchs and

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Felton with the motivation of allowing a customer to receive the most suitable quotation for insurance over the Internet (Cullen: col. 1 line 60 to col. 2 line 11).

Luchs, Felton and Cullen fail to teach:

--the claimed receiving a further signal from the customer-operated terminal indicating that the desire insurance is still desired; and

--the claimed concluding an arrangement so that the desired insurance coverage concerning the time period is provided to the customer.

Underwood et al. teaches a computer-implemented system for managing underwriting, quoting and binding insurance companies, where at step 132, if a quote is accepted by the user a policy is issued and accepted using a graphical user interface (see: column 6, lines 38-45 and Fig. 13). In addition, Underwood et al. teaches a system for quoting, binding and later issuing an insurance contract in which all relevant information pertaining to the risk is properly documented and permanently stored (reads on “(8) recording information regarding the desired insurance coverage as restricted by the limitation in an insurance company database.”) (see: Underwood et al.: column 1, lines 60-64).

One of ordinary skill in the art at the time the invention was made would have found it obvious to include the computer-implemented system for managing underwriting, quoting and binding insurance companies as taught by Underwood et al. with the system as taught by Luchs, Felton and Cullen with the motivation of providing a system for quoting, binding and later issuing an insurance contract in which all relevant information pertaining to the risk is properly documented and permanently stored (see: Underwood et al.: column 1, lines 60-64).

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Luchs, Felton, Cullen and Underwood et al. disclose obtaining details of a user's requirements for an insurance quotation via a user's computer, receiving by way of a mobile agent, the user's requirements for an insurance quotation at a server, and delivering the insurance quotation information, such as the types of insurance available and the price of the insurance based on insurer-specific underwriting rules, to the user at the user's computer, wherein the user's computer is operated by a customer wishing to purchase vehicle insurance, wherein information is provided to and from the customer's computer and the servers via the Internet (see: Cullen: Fig. 1, col. 1 lines 10-18, col. 2 lines 1-11, col. 3 lines 1-21, col. 6 line 60 to col. 7 line 15, col. 7 line 15 to col. 8 line 32).

Luchs, Felton, Cullen and Underwood et al. fails to expressly disclose (7) receiving credit card information from the customer.

Pescitelli discloses payment for a policy being made by credit card, wherein the credit card is inserted into a credit card reader and is authorized (col. 2 lines 4-13).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the aforementioned features of Pescitelli with the method taught collectively by Luchs, Felton, Cullen and Underwood et al. with the motivation of allowing a customer to pay for insurance immediately (Pescitelli; col. 2 lines 4-13).

(10) Response to Argument

In the Appeal Brief filed 26 May 2009, Appellant makes the following arguments:

(A) Applicant disagrees with the Examiner's contention in particular that it would have been obvious to one of ordinary skill in the art to combine Felton with Luchs et al.

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(B) The Examiner has not demonstrated a two-part methodology of acquiring insurance including a first set of steps (a) that occur specifically “during a preliminary period of time” but also a second set of steps encompassed by part (b) that occur specifically “at a subsequent period of time”.

(C) The combination of Luchs et al. with all of the references merely represents an exercise of improper hindsight reasoning.

Examiner will address Appellant’s arguments in sequence as they appear in the brief.

Response to Argument (A):

In response to the first argument, the Examiner respectfully submits and recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *See In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). However, that the motivation to combine the teachings of Luchs et al., Felton, Cullen et al., Underwood et al. and/or Pescitelli et al. is given in the previous Office Action (dated 7/24/08) from suggested passage within the references.

Furthermore, it is respectfully submitted that the key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR* noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Court quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006), stated that “[R]ejections on obviousness cannot be

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sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR*, 550 U.S. at ___, 82 USPQ2d at 1396. An example of rationale that may support a conclusion of obviousness include: (G) Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention See MPEP § 2143. Furthermore, if the search of the prior art and the resolution of the *Graham* factual inquiries reveal that an obviousness rejection may be made using the familiar teaching-suggestion-motivation (TSM) rationale, then such a rejection should be made. Although the Supreme Court in *KSR* cautioned against an overly rigid application of TSM, it also recognized that TSM was one of a number of valid rationales that could be used to determine obviousness. (According to the Supreme Court, establishment of the TSM approach to the question of obviousness “captured a helpful insight.” 550 U.S. at ___, 82 USPQ2d at 1396 (citing *In re Bergel*, 292 F.2d 955, 956-57, 130 USPQ 206, 207-208 (1961))).

Response to Argument (B):

In response to the second argument, the Examiner respectfully submits that the Luchs reference is relied on for teaching that a client can request supplemental coverage or add further risks to a policy or rider (see: col. 1 lines 50-62). In addition, it is noted that the feature upon which applicant relies step one “(a) during a preliminary period of time:... (2) providing an input form...a characteristic of an item to be insured” refers to inputting information about an item to be insured. The second step recites “(b) at a subsequent period of time:... insurance coverage regarding a customer-owned item” refers to a separate item that needs insurance coverage and does not refer back to “an item to be insured” in the previous step of “(a) during a preliminary

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period of time”. Therefore, the Luchs reference need only teach the ability to request supplemental coverage or **add further risks** to a policy or rider **at different times** without having to refer back to an item using the previous identifier in step one and because the recited “a customer-owned item” in step one is not recited as "said customer-owned item" in the second step.

Response to Argument (C):

In response to the third argument, the Examiner respectfully submits that it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the Applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In addition, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In addition, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Moreover, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account

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only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the Applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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